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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,621	10/14/2003	Charles M. Watkins	2269-5923US (03-0306.00/U)	3766
24247	7590	04/18/2005	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			NGUYEN, VINH P	
			ART UNIT	PAPER NUMBER
			2829	

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/684,621

Applicant(s)

WATKINS ET AL.

Examiner

VINH P. NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 6-9, 16-19, 21-38, 44-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 11, 12, 15, 39, 40 and 43 is/are rejected.
- 7) ☒ Claim(s) 3, 4, 10, 13, 14, 20, 41, 42 and 48 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. Applicant's election without traverse of species of figure 1-3 and 8 including claims 1-5,10-15,20,39-43 and 48 in the reply filed on 03/28/05 is acknowledged.
2. Claims 6-9,16-19,21-38,44-47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 03/28/05.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,5,11,15 are rejected under 35 U.S.C. 102(b) as being anticipated by Ponn (Pat # 4,008,300).

As to claims 1 and 11, Ponn discloses an apparatus as shown in figure 1 having a substantially planar substrate (12) and a plurality of conductive compliant contacts (18). It is noted that a portion of each compliant contacts(18) is fixed within a portion of the substrate and at least one laterally unsupported portion (top portion of the contact "18" not located within the substrate) and extending beyond one side.

As to claims 5 and 15, the unsupported portion of the compliant contact (18) is orthogonally compliant with respect to a plane of the substrate as shown in figure 2.

5. Claims 39 and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Beaman et al (pat # 5,785,538).

As to claim 39, Beaman et al disclose an a contactor card as shown in figure 1 having a substantially planar substrate (17), a plurality of conductive compliant contacts (15) carried by the substrate of the card and arranged in a pattern selected for contact with contact pads (21) of a semiconductor substrate under test (20) and wherein each contact includes a portion fixed within a portion of the substrate and at least one laterally unsupported portion (16) integral with the portion fixed within the portion of the substrate of the card. Beaman et al do not show a tester operably coupled to the contactor card . However, since the contactor card is used for testing the device under test (20), the apparatus of Beaman et al inherently has a tester connected to that card in order to perform the test.

As to claim 43, the unsupported portion of the compliant contact (18) is orthogonally compliant with respect to a plane of the substrate as shown in figure 2.

6. Claims 1,5,11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Beaman et al (pat # 5,785,538).

As to claims 1 and 11, Beaman et al disclose an a contactor card as shown in figure 1 having a substantially planar substrate (17), a plurality of conductive compliant contacts (15) carried by the substrate of the card and arranged in a pattern selected for contact with contact pads (21) of a semiconductor substrate under test (20) and wherein each contact includes a portion fixed within a portion of the substrate and at least one laterally unsupported portion (16) integral with the portion fixed within the portion of the substrate of the card.

As to claims 5 and 15, the unsupported portion of the compliant contact (18) is orthogonally compliant with respect to a plane of the substrate.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ponn (Pat # 4,008,300).

As to claims 2,12, the cross section of the compliant contact of Ponn is not a rectangular shape. However, it would have been obvious for one of ordinary skill in the art to make the compliant contact of Ponn in rectangular shape , this is an obvious design choice since changes in shape are not given any patentable weight according to In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

9. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beaman et al (pat # 5,785,538).

As to claim 40, the cross section of the compliant contact of Beaman et al is not a rectangular shape. However, it would have been obvious for one of ordinary skill in the art to

make the compliant contact of Beaman et al in rectangular shape , this is an obvious design choice since changes in shape are not given any patentable weight according to In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

10. Claims 3-4,10,13-14,20,41-42,48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art does not disclose a substrate with a recess extending peripherally about the at least one laterally unsupported portion of the compliant contact, a conductive elements coupled to the portion of the compliant contact fixed within the substrate and extending across a side ,a dielectric layer laterally surrounding the portion of the compliant contact as recited in claims 3-4,10,13-14,41-42.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Takashi et al (pat # 4,408,814) disclose electric connector of press contact holding type.


Sado (Pat # 4,402,562) disclose interconnectors.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VINH P. NGUYEN whose telephone number is 571-272-1964. The examiner can normally be reached on 6:30AM-4:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on 571-272-2034. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
VINH P NGUYEN  
Primary Examiner  
Art Unit 2829  
04/14/05